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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/886,208      | 06/22/2001  | Steven F. Fabijanski | S&B-C099            | 5580             |

30132 7590 10/03/2002

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EXAMINER

FOX, DAVID T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1638

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/086,208

Applicant(s)

Fabijanski et al

Examiner

FDX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 6/21/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 98-119 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 98-119 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The preliminary amendment filed in the PCT application on 21 March 2001 has not been entered because it was unsigned. Thus, pages 65-68 and 70-71 were not replaced, and claims 12-97 were not amended. The proposed amendments to claims 12-97 are moot in view of the entry of the preliminary amendment of 21 June 2001 which cancelled claims 12-97. However, Applicants should resubmit amendments to pages 65-68 and 70-71 in accordance with 37 CFR 1.121(c). The submission of substitute pages in U.S. applications is not permitted.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 98-99, 101, 103-106, 110-113 and 118-119, drawn to methods of introducing a lethal gene such as a toxin-encoding gene and a repressor to that lethal gene such as an antisense RNA-encoding sequence, classified in class 800, subclass 286, for example.
  - II. Claims 100, 108 and 109, drawn to methods of introducing conditional lethal genes such as hormone production genes, classified in class 800, subclass 290, for example.
  - III. Claim 102, drawn to a method of introducing a recombinase or a transposase-encoding gene into a plant, classified in class 800, subclass 291, for example.
  - IV. Claims 107 and 114-116, drawn to methods of introducing an operator and an operator-binding repressor gene into a plant, classified in class 800, subclass 288, for example.
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- V. Claim 117, drawn to a method of incorporating an operator/repressor-encoding gene combination and genes encoding a recombinase or a transposase, classified in class 435, subclass 468, for example.

The inventions are distinct, each from the other because:

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different effects.

The invention of Group I involves toxin-encoding lethal genes not required by Group II, and antisense RNA or ribozyme- encoding genes each not required by any other group. The invention of Group II involves growth hormone pathway genes and methods for determining altered plant growth habit, each not required by any other group. The invention of Groups III and V involve recombinase or transposase- encoding genes not required by Groups I-II and IV. The inventions of Groups IV-V involve operators and DNA binding protein-encoding genes, not required by Groups I-III. The invention of Group V methods for evaluating the interaction of operators and DNA binding protein-encoding genes with transposase- or recombinase- encoding genes, not required by any other group. Furthermore, the constructs of the inventions of Groups III and IV can be practiced in methods other than Group V, such as methods involving only the individual constructs rather than their combination.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

September 30, 2002

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180

1638  
